

ESTTA Tracking number: **ESTTA381885**

Filing date: **12/03/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197078
Party	Defendant S.P. Grossnickle, LLC dba Forty-Five North Vineyard and Winery
Correspondence Address	JAMES D HALL BOTKIN & HALL, LLP 105 E JEFFERSON BLVD, SUITE 400 SOUTH BEND, IN 46601-1913 UNITED STATES
Submission	Answer
Filer's Name	Steven L. Smilay
Filer's e-mail	sls@bhlawyers.net, mgs@bhlawyers.net
Signature	/Steven L. Smilay/
Date	12/03/2010
Attachments	Answer to Opposition.pdf ( 5 pages )(78099 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

-----	X	
	:	
PAUL JABOULET AINE	:	
	:	
Opposer,	:	Opposition No. 91197078
	:	Serial No. 77806650
v.	:	
	:	
S.P. GROSSNICKLE, LLC	:	
	:	
Applicant.	:	
-----	X	

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**ANSWER TO NOTICE OF OPPOSITION**

S.P. GROSSNICKLE, LLC hereby Answers the Notice of Opposition of PAUL JABOULET AINE and admits, denies and alleges as follows:

1. In response to the Paragraph 1 of Opposer's Notice of Opposition, Applicant admits that Applicant is seeking to register the mark 45 and design for wine.
2. In response to Paragraph 2 of Opposer's Notice of Opposition, Applicant lacks sufficient knowledge, information or belief upon which to base a response to the allegations of said paragraph and on that basis denies each, every and all of said allegations.
3. In response to Paragraph 3 of Opposer's Notice of Opposition, Applicant admits that, the records of the United States Patent and Trademark Office indicate that Opposer is the owner of Registration

No. 2,682,366 for PARALLELE 45 and that said records indicate that the registration is incontestable. Except as expressly admitted herein, Applicant lacks sufficient knowledge, information or belief upon which to base a response to the allegations of said paragraph and on that basis denies each, every and all of said allegations.

4. In response to Paragraph 4 of Opposer's Notice of Opposition, Applicant lacks sufficient knowledge, information or belief upon which to base a response to the allegations of said paragraph and on that basis denies each, every and all of said allegations.
5. In response to Paragraph 5 of Opposer's Notice of Opposition, Applicant lacks sufficient knowledge, information or belief upon which to base a response to the allegations of said paragraph and on that basis denies each, every and all of said allegations.
6. In response to the second paragraph of Opposer's Notice of Opposition which is designated as Paragraph 4, Applicant admits that Exhibit A is a printout from the electronic database records of the USPTO, namely TARR, and the Assignment Records and that said records show that Registration No. 2,682,366 is in the name of Opposer.
7. In response to the second paragraph of Opposer's Notice of Opposition which is designated as paragraph 5, Applicant lacks sufficient knowledge, information or belief upon which to base a response to the allegations of said paragraph and on that basis denies each, every and all of said allegations.

8. In response to Paragraph 6 of Opposer's Notice of Opposition, Applicant denies each, every, and all of the allegations thereof.
9. In response to the Paragraph 7 of Opposer's Notice of Opposition, Applicant admits that the stylized format depicted in Opposer's Opposition is an accurate rendition of the 45 and design mark which is the subject of Applicant's application for registration.
10. In response to Paragraph 8 of Opposer's Notice of Opposition, Applicant denies, each, every, and all of the allegations contained therein.
11. In response to Paragraph 9 of Opposer's Notice of Opposition, Applicant admits that both its goods and those of Opposer are "wines."
12. In response to Paragraph 10 of Opposers' Notice of Opposition, Applicant denies each, every, and all of the allegations contained therein.

### **AFFIRMATIVE DEFENSES**

In further answer to the Notice of Opposition, Applicant asserts that:

#### **FIRST AFFIRMATIVE DEFENSE**

13. Opposer's Notice of Opposition fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the opposition.

#### **SECOND AFFIRMATIVE DEFENSE**

14. The term "PARALLELE" is descriptive and highly diluted as a trademark formative, and hence weak, and Opposer's purported rights

extend no further than to the specific marks which Opposer alleges it owns, none of which are the same as or confusingly similar to Applicant's mark in terms of connotation, appearance and/or pronunciation.

### **THIRD AFFIRMATIVE DEFENSE**

15. Applicant's use of its mark will not mistakenly be thought by the public to derive from the same source as Opposer's goods, nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization or approval.

### **FOURTH AFFIRMATIVE DEFENSE**

16. Applicant's mark in its entirety is sufficiently distinctively different from Opposer's marks to avoid confusion, deception or mistake as to the source or sponsorship or association of Applicant's goods.

### **FIFTH AFFIRMATIVE DEFENSE**

17. Applicant's mark, when used on Applicant's goods, is not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods by Opposer.

### **SIXTH AFFIRMATIVE DEFENSE**

18. Opposer's mark is not subject to anti-dilution protection since its mark is not strong, famous or distinctive.

## **RELIEF REQUESTED**

**WHEREFORE**, Applicant respectfully requests that this opposition proceeding be dismissed, with prejudice.

Dated: December 3, 2010

Respectfully submitted,

/Steven L. Smilay/  
Steven L. Smilay (26233-43)  
BOTKIN & HALL, LLP  
105 East Jefferson Blvd., Ste. 400  
South Bend, Indiana 46601  
Telephone: (574) 234-3900  
Fax: (574) 236-2839  
Attorney for Applicant/Defendant

## **CERTIFICATE OF SERVICE**

The undersigned certifies that a copy of the foregoing has been served upon the following via United States Regular Mail on December 3, 2010:

Julie B. Seyler, Esq.  
Abelman, Frayne & Schwab  
666 Third Avenue  
New York, New York 10017

/Steven L. Smilay/  
Steven L. Smilay